

Appl. No. 09/814,260
Amdt. Dated 10/20/2005
Office Action mailed 9/20/2005

REMARKS

Applicants appreciate the recognition of patentable subject matter in the present application.

Applicants hereby cancel claim 137 and add new claims 148-149 which are supported at least by the original specification at pages 7-9.

The Examiner has required restriction under 35 U.S.C. §121 between Species I: Monitoring turbidity and Species II: Monitoring a percent of solids present within a liquid of the process fluid.

Applicants respectfully traverse the restriction and urge allowance of the pending claims.

Applicants submit this response to the restriction *with traverse*. If the restriction is not withdrawn, Applicants elect species I and claims 68-72, 74-95, 103, 105-106, 118-126, 128-136, 138-139, 141, 143-145, and 147-149. However, the restriction is improper for the following reasons.

Referring to MPEP §806.04(b) (8th ed., rev. 2), restriction of alleged species is only proper if restriction is proper under both species practice and practice related to other types of restriction (MPEP §806.05 - 05.(i)). Applicants respectfully submit restriction is improper under both practices for at least the following reasons and Applicants respectfully request withdrawal of the restriction requirement.

According to MPEP §806.04(f) (8th ed., rev. 2), it is stated that *claims to be restricted to different species must be mutually exclusive*. The general test as to when claims are

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restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a *first species but not a second*, while a second claim recites limitations *disclosed only for the second species and not the first*. This is frequently expressed by saying that ***claims to be restricted to different species must recite the mutually exclusive characteristics of such species.***

The claims reciting monitoring a percent of solids present within a liquid and the claims reciting monitoring turbidity *do not recite mutually exclusive characteristics of different species* as required for proper restriction under the above-rected MPEP section. To the contrary, the specification at page 9 provides one meaning of turbidity as including percent solids within a liquid.

Even more compelling is the fact that ***dependent claims 140, 142, and 146 further define the monitoring turbidity of the respective base claims 68, 103 and 126 as monitoring a percent of solids present within a liquid.*** Accordingly, the ***species can not be found to recite mutually exclusive characteristics when the alleged species of claims 140, 142 and 146 further define the species of the base claims.*** It is clear from such dependency that alleged species I is generic to alleged species II, the alleged species do not recite mutually exclusive characteristics as required and the rejection is improper for at least this reason.

The limitations identified by the Office as allegedly being different species *fail to recite mutually exclusive characteristics* of different species as is required for proper restriction and MPEP §806.04(f) makes clear that election is improper for the above

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reasons alone. Accordingly, restriction is not proper under the practice related to election of species as set forth by MPEP 806.04(f) and restriction is improper under MPEP 806.04(b).

The Office has also failed to establish that the species are distinct as set forth by MPEP 806.05 (8th ed., rev. 2). Applicant also refers to MPEP 808.02 (8th ed., rev. 2) entitled Related Inventions which further discusses restriction under 806.05. It is stated in such MPEP section that even if restriction is proper under MPEP §806.05, the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (a) separate classification, (b) separate status in the art when they are classifiable together, or (c) a different field of search. It is further stated in MPEP 808.02 that where the classification is the same and field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist dividing among related inventions.

The restriction requirement issued September 19, 2005 is entirely void of any indication of the alleged species being separately classified, achieving separate status in the art when the species are classifiable together, or requiring a different field of search. Section B of MPEP 808.02 states that separate status in the art may be shown by citing patents which are evidence of such separate status, and also separate field of search. *No patents have been cited or other evidence offered to indicate separate status.* There is no indication that a different classification is provided or a different field of search is required. No clear indication of separate future classification and field of search is provided. As mandated by MPEP 808.02, no reasons exists for dividing among related inventions.

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Applicant further contends that any restriction is improper for at least the following reasons. Restriction is not proper since there is increased burden on the U.S. Patent and Trademark Office, on the Applicant and ultimately on the public in prosecuting multiple separate patent applications. For Applicant, splitting the invention into multiple cases increases costs associated with government fees, prosecution fees, and maintenance fees for multiple patents. For the PTO, there are increased costs associated with conducting multiple searches in multiple applications and multiple examinations for an invention that already has been searched and examined. It further ultimately produces a burden on the pertinent public that will review Applicant's commonly patented technology. Such people will be compelled to unnecessarily review multiple issued patents and file histories.

Pursuant to MPEP 803 (8th ed., rev. 2), it is stated that *if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions*. Applicant respectfully submits no serious burden exists and Applicant respectfully requests withdrawal of the restriction requirement for this additional reason.

In sum, the Office has failed to establish pursuant to MPEP §806.04(f) (8th ed., rev. 2) that the claims recite mutually exclusive characteristics of the species. Accordingly, restriction under species practice is not appropriate pursuant to MPEP §806.04(b) and Applicants respectfully request withdrawal of the restriction requirement for at least this reason.

Further, the Office has not established that the inventions are distinct under MPEP 806.05(c) and even if the inventions are distinct, restriction is not proper under MPEP

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808.02 and MPEP 803. Accordingly, restriction is again not proper pursuant to MPEP §806.04(b).

For at least the above-mentioned compelling reasons, Applicants respectfully assert that restriction is improper, and request that the Examiner withdraw the restriction requirement and consider the pending claims in this application at this time.


Applicants submit a copy of the Information Disclosure Statement and Form PTO-1449 filed July 7, 2005. The Examiner initialed references AA and AF but did not initial references AB-AE (copy of initialed Form PTO-1449 included). Applicants request initialization of these references and the Form PTO-1449 returned to Applicants.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 10/20/05

By: 
James D. Shaurette
Reg. No. 39,833

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Sheet 1 of 1

Form PTO-1449		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO. M122-1663		SERIAL NO. 09/814,260		
LIST OF ART CITED BY APPLICANT (Use several sheets if necessary)				APPLICANT Scott B. Moore et al.				
				FILING DATE March 21, 2001		GROUP 3724		
U.S. PATENT DOCUMENTS								
*Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date If Appropriate	
TR	AA	6,096,185	8/1/2000	Corlett et al.				
	AB	4,282,745	8/1981	Burr, Kenneth J.				
	AC	4,457,624	7/1984	Goldberg et al.				
	AD	5,194,921	3/1993	Tambo et al.				
	AE	3,695,763	10/1972	Shiuh, Jerome				
TR	AF	5,750,440	5/1998	Vanell et al.				
	AG							
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	AL							
FOREIGN PATENT DOCUMENTS								
		Document Number	Date	Country	Class	Subclass	Translation	
							Yes	No
	AM							
	AN							
	AO							
OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, Etc.)								
	AP							
EXAMINER <i>Timothy V. Eley</i>				DATE CONSIDERED <i>09/19/05</i>				
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.								

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PAGE 25/25 * RCVD AT 7/7/2005 7:48:50 PM [Eastern Daylight Time] * SVR:USPTO-EF-XRF-1/25 * DNS:2738300 * CSID:5098383424 * DURATION (mm-ss):07-30

PAGE 23/25 * RCVD AT 10/20/2005 7:49:36 PM [Eastern Daylight Time] * SVR:USPTO-EF-XRF-6/24 * DNS:2738300 * CSID:5098383424 * DURATION (mm-ss):06-12

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/814,260
Filing Date March 21, 2001
Inventor Scott E. Moore et al.
Assignee Micron Technology, Inc.
Group Art Unit 3723
Examiner T. Eley
Attorney's Docket No. MI22-1663
Title: "Semiconductor Workpiece Processing Methods, A Method of Preparing
Semiconductor Workpiece Process Fluid, and A Method of Delivering
Semiconductor Workpiece Process Fluid to a Semiconductor Processor"

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT


References -- See Attached Form PTO-1449

The attached form PTO-1449 is submitted in compliance with 37 CFR §1.56. No
admission is made regarding whether all the submitted references are prior art.

Respectfully submitted,

Dated: 7/7/05

Attorney:


James D. Shaurette
Reg. No. 39,833

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Sheet 1 of 1

Form PTO-1449		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO. MI22-1663		SERIAL NO. 09/814,260	
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